

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte BRUCE P. MURCH, BRIAN J. ROSELLE
and KYLE D. JONES

Appeal No. 1998-0370
Application 08/568,410

HEARD: February 06, 2001

Before, WARREN, WALTZ and JEFFREY T. SMITH, Administrative Patent Judges.

JEFFREY T. SMITH, Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

Applicants appeal the decision of the Primary Examiner rejecting claims 1-10, which are all the claims in the application.¹ We have jurisdiction under 35 U.S.C. § 134.²

¹ See Appeal Brief page 2. Contrary to Appellants' assertion, claim 2 was not subject to the final rejection. (See paper no. 22, mailed October 16, 1996). Accordingly, for purposes of this appeal we review the Examiner's rejection of claims 1 and 3-10.

² The Examiner indicated in the Advisory action, paper no. 25, mailed February 6, 1997 that the after final amendment, filed January 16, 1997, would be entered upon filing an appeal. We observe

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BACKGROUND

The invention is drawn to a composition suitable for cleaning produce especially fruits and vegetables. The claimed compositions are said to contain only ingredients that are generally regarded as safe. Claim 1 which is representative of the invention is reproduced below:

1. A composition suitable for cleaning produce, even when the composition is incompletely removed from said produce, containing only Generally Regarded As Safe ingredients.

As evidence of obviousness, the Examiner relies on the following references:

Kitamura et al. (Kitamura)	5,306,444	April 26, 1994
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United States Code of Federal Regulations, Title 21 § 173.315, April 1, 1992.³
(21 CFR § 173.315)

The Board relies on the following reference as basis for entering a new ground of rejection:

Tricca	5,320,772	June 14, 1994 (filed May 18, 1992)
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that the amendment of January 16, 1997 has not been clerically entered. However, for purposes of this appeal, we will consider claim 1 on appeal as if the amendment of Jan. 16, 1997, was correctly entered.

³ We note that appendix III of Appellants' Brief contains the 1995 version of 21 CFR § 173.315.

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Appellants have indicated (Brief, page 2) that, for the purposes of this appeal, “all claims can be considered together.” Appellants argue all of the claims together. As stated in 37 CFR § 1.192(c)(7)(1995),

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. (Underlining added for emphasis)

Appellants have failed to explain why the additional features of dependent claims 3-10 are separately patentable. Therefore, we have limited our consideration of the issues raised by this appeal as they apply to claim 1.

OPINION

Our initial inquiry is directed to the scope of the claimed subject matter. During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, and the claim language is to be read in view of the specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548,

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218 USPQ 385, 388 (Fed. Cir. 1983); *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976).

Claim 1 requires the composition to contain ingredients which are “Generally Regarded As Safe” (GRAS). In order to determine the limitations of GRAS, we look to the specification. The specification refers to United States Code of Federal Regulations, Title 21 Section 173.315. (Specification, page 2, lines 17-23). Section 173.315 provides regulations for substances to be used in washing or to assist in the lye peeling of fruits and vegetables. Section 173.315 does not provide an exhaustive list of GRAS ingredients. Section 173.315 does not expressly provide a definition for GRAS or refer to a specific section of the United States Code of Federal Regulations for a definition.⁴ Since the specification does not provide a definition for GRAS, we will use the plain and ordinary meaning for the phrase, that is, the composition contains only ingredients that will not harm humans. *See In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (when interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that the words were used differently by the inventor.) In sum, our construction of the subject matter defined by Appellants’ claim 1 is that the claimed subject matter is directed to a

⁴ We note that 21 CFR § 182.1 describes “substances that are generally recognized as safe.” This section does not provide an exhaustive list of substances generally recognized as safe. Specifically this section states: “ it is impracticable to list all substances that are generally recognized as safe for their intended use.”

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composition suitable for cleaning produce containing only ingredients that will not harm humans.

Upon careful review of the entire record including the respective positions advanced by Appellants and the Examiner, we find that the Examiner has carried his burden of establishing a *prima facie* case of obviousness and that this *prima facie* case has not been effectively rebutted by Appellants. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). Accordingly, we will sustain the Examiner's rejection.

Claims 1 and 3-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Kitamura, 21 CFR § 173.315 and the admitted prior art. (Examiner's answer, page 4). We affirm the rejection stated in the Examiner's Answer and add the following.

The washing of fruits and vegetables prior to consumption is well known. The purpose of washing fruits and vegetable is to remove dirt and other surface contaminants. Claim 1 is drawn to compositions containing only ingredients which are GRAS, that is, are not harmful to humans. A review of the art cited throughout the present record exhibits the use of compositions to clean or wash fruits and vegetables are known to those of ordinary

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skill in the art.⁵ These compositions are composed of ingredients which are said to be acceptable for the use on foods.⁶ Thus, we determine that one of ordinary skill in the art is imputed with knowledge regarding the suitability of forming compositions for cleaning fruits and vegetables which are not harmful to humans.

The Food and Drug Administration provides regulations for foods which are to be sold in the United States. Regulation 21 CFR § 173.315 is entitled “Chemicals used in washing or to assist in the lye peeling of fruits and vegetables.” Section 173.315 describes conditions, amounts and preparation of substances suitable for washing fruits and vegetables or assisting in the lye peeling of fruits and vegetables. Section 173.315 also describes substances which are used in conjunction with flume water for washing sugar beets. (21 CFR § 173.315(a)(3)). Kitamura describes detergent compositions which are said to be suitable for cleaning vegetables and fruits. (Column 2, lines 51-58). Kitamura

⁵ It is axiomatic that admitted prior art in an applicants’ specification may be used in determining the patentability of a claimed invention. (**In re Nomiya**, 509 F.2d 566, 570-71, 184 USPQ 607, 611-12 (CCPA 1975)); and that consideration of the prior art cited by the Examiner may include consideration of the prior art found in applicants’ specification. (**In re Davis**, 305 F.2d 501, 503, 134 USPQ 256, 258 (CCPA 1962); cf., **In re Hedges**, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986)).

⁶ The information disclosure statement, filed October 14, 1994, includes numerous references which describe compositions suitable for the cleaning of fruit and vegetables. For example see the following: DE 4,023,418, (Translation page 1 first paragraph); 4,002,579 (Column 1, first paragraph); 4,808,330 (Column 1, line 59 to column 2, line 8); and 4,140,649.

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also discloses that the detergent compositions contain ingredients that are harmless to the human body. (Column 1, lines 11-18 and column 2, lines 19-22).

One of ordinary skill in the art equipped with the knowledge of Kitamura, 21 CFR § 173.315 and the descriptions of the prior art would have been motivated to form detergent compositions of Kitamura employing only components which are generally regarded as safe because the compositions would be used to clean fruits and vegetables. As stated above, the prior art discloses components used to clean fruits and vegetables must not harm humans. Thus, one of ordinary skill in the art, when forming Kitamura's composition for washing fruits and vegetables, would have recognized that the composition should contain ingredients that were not harmful to humans. Knowledge generally available to one skilled in the art can provide the motivation to combine the relevant teachings. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985). The motivation to combine the relevant teachings of references may come from knowledge of those skilled in the art that certain references, or disclosures in the references, are known to be of special interest or importance in the particular field. *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

Appellants argue that it would not be obvious to eliminate the essential protease inhibitor of Kitamura based upon the Code of Federal Regulations. (Brief, page 3, third

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paragraph). The need to eliminate the protease inhibitor has not been established on this record. Kitamura describes detergent compositions with a variety of uses including washing fruits and vegetables. Section 173.315 describes the use and selection of ingredients for the purpose of washing fruits and vegetables. As stated above, one of ordinary skill in the art equipped with the knowledge of Kitamura, 21 CFR § 173.315 and the admitted prior art would have been fully motivated to form compositions suitable for washing fruits and vegetable which would not be harmful to humans.⁷

Appellants urge there is no listing in 21 CFR § 173.315 for protease inhibitors. (Brief, page 3, fourth paragraph). Appellants also filed a declaration under 35 U.S.C. § 132 (paper no. 16, filed December 6, 1995) which states that protease inhibitors are not GRAS. Declarant's opinion is based upon inspection of portions of 21 CFR in addition to § 173.315. Declarant does not discuss the teaching in Kitamura regarding the compositions as harmless to humans. There is no discussion that any of Kitamura's described compositions would not meet the limitations of claim 1. For these reasons, the declaration is not probative. Declaration evidence must be considered, but will not be considered

⁷ We further note that Kitamura discloses the purpose of protease inhibitors in the composition is to provide amelioration of skin irritation. (Column 2, lines 33-43). Kitamura also discloses detergent compositions which exclude protease inhibitors. (Note comparative examples, columns 9-11). One of ordinary skill in the art who did not desire amelioration of skin irritation would have been motivated to exclude a protease inhibitor from the detergent composition. **See Ex parte Wu**, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

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probative if it does not address the facts of record. *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992).

When the prior art appears to provide a product identical to the product claimed, the Appellants have the burden to submit evidence, commensurate in scope with the claims, that the products are different. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Appellants have failed to direct us to evidence that the compositions of Kitamura which exclude protease inhibitors are different from the compositions of claim 1.

The rejection of claims 1 and 3-10 under U.S.C. § 103 as being unpatentable over the combination of Kitamura, 21 CFR § 173.315 and the admitted prior art is affirmed.

NEW REJECTIONS

Under the provisions of 35 U.S.C. § 196(b), we make the following new grounds of rejection.

I.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Kitamura, 21 CFR § 173.315 and the admitted prior art as applied to claims 1 and 3-10 above. Claim 2 adds the following limitation to the subject matter of claim 1:

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“wherein said composition is aqueous and contains from about 0.5% to about 15% by weight of detergent surfactant.”

The amount of surfactant contained in detergent compositions is well known to one of ordinary skill in the art. Kitamura example I-11 describes a detergent composition for the kitchen which contains 13 percent surfactant. (Column 11, Table I-4). As stated above, Kitamura discloses that the detergent compositions contain ingredients that are harmless to the human body. One of ordinary skill in the art equipped with the knowledge of Kitamura, 21 CFR § 173.315 and the descriptions of the prior art would have been motivated to form detergent compositions containing from about 0.5% to about 15% by weight of surfactant and employing only components which are generally regarded as safe because the compositions would be used to clean fruits and vegetables. As stated above, the prior art discloses components used to clean fruits and vegetables must not harm humans. Thus, one of ordinary skill in the art, when forming Kitamura’s composition for washing fruits and vegetables, would have recognized that the composition should contain ingredients that were not harmful to humans.

II.

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Claims 1-8 are rejected under 35 U.S.C. § 102(e) as anticipated by Tricca.⁸ Tricca discloses aqueous compositions suitable for cleaning fruits and vegetables composed of ingredients that have been approved by the Food and Drug Administration as GRAS. (Column 1, lines 42-66). Tricca discloses the use of surfactant in amounts which anticipate claims 1-4 and 6-8. (See examples and column 3, line 57 to column 4, line 25). Claim 5 is anticipated by Tricca which discloses the use of acid and buffering agents to maintain a pH of 9. (Column 4, lines 44-46).

CONCLUSION

In summary, we affirm the Examiner's decision rejecting claims 1 and 3-10 under 35 U.S.C. § 103. We reject claims 1-8 under 35 U.S.C. § 102(e) and claim 2 under 35 U.S.C. § 103.

In addition to affirming the Examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR §1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

⁸ We have not determined the suitability of rejecting claims 9 and 10 under 35 U.S.C. 103 over Tricca. If Appellants choose to pursue prosecution before the Examiner, the Examiner is free to make all appropriate obviousness determinations including additional references in combination with Tricca.

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(b) Appellants may file a single request for rehearing within two months from the date of the original decision . .

37 CFR § 1.196(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. .
..

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the Appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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Time for taking action

No time period for taking any subsequent action in connection with this appeal may
be extended under 37 CFR § 1.136(a).

AFFIRMED 196(b)

THOMAS J. WALTZ
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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WARREN, *Administrative Patent Judge*, Concurring:

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I concur entirely with the panel's decision and supporting opinion. I make the following finding to emphasize the breadth of at least appealed claims 1, 2 and 6.⁹ It is reasonable to take notice that tap water and dishwashing detergent, separately or in combination, are compositions that have long been in common use "for cleaning produce" in the home. In my view, plain tap water, as processed by municipal water treatment systems, is a composition containing ingredients regarded as safe for human consumption, even when incompletely removed from produce cleaned therewith, and thus falls within claim 1. It is further known that commercially available dishwashing detergent is a composition that is regarded as safe for human consumption when incompletely removed from produce cleaned therewith, such as by rinsing with tap water, and thus falls within claim 1 as well as within claims 2 and 6 where the commercially available dishwashing detergent contains at least one detergent surfactant in the amount of about 0.5% to about 15% by weight. It is still further known that commercially available dishwashing detergent is commonly used in combination with tap water, the resulting composition regarded as safe for human consumption when incompletely removed from produce cleaned therewith, and thus would fall within claims 1, 2 and 6. Accordingly, the examiner should consider whether at least appealed claims 1, 2 and 6 comply with 35 U.S.C. § 102(b) because compositions comprising tap water and dishwashing detergent, separately or in combination, and methods of using the same to

clean produce were "in public use or on sale in this country" more than one year before the effective filing date of the subject application.

⁹ The examiner should consider whether claim 6 as amended in the amendment of July 23, 1996 (Paper No. 21) complies with 35 U.S.C. § 112, second paragraph.

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CHARLES F. WARREN
Administrative Patent Judge

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